



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,017	11/22/2000	Winnie C. Durbin	GEMS8081.023	5745

27061 7590 11/13/2003

ZIOLKOWSKI PATENT SOLUTIONS GROUP, LLC (GEMS)
14135 NORTH CEDARBURG ROAD
MEQUON, WI 53097

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,017

Applicant(s)

DURBIN ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-26 have been examined.

Response to Amendments

2. Claim 1 recites "receiving a user ID at a centralized facility from a user" which is equivalent to a user sending a user ID to a central facility and the central facility receiving the user ID. A feature clearly taught by Neville et al. (figure 8; column/line 13/13-14/15). Regarding "specifying an option", to one of ordinary skill a valid interpretation is the "option" of desiring to continuing to use the software application (column/line 13/13-14/15). Note the user has the option not to do so. Regarding "key creation" (claim 10), Neville et al. teach securing communications between end-user and server using public/private and/or symmetric key encryption. Hence, the Neville et al. system creates a software key, the encrypted software-enabling key, in response to a user request (column 13, lines 44-50). This definition of the term "create" is in line with Webster's Ninth New Collegiate Dictionary as it defines "create" as "to produce or bring about by a course of action or behavior". Regarding "system ID" (claim 18), the Applicant has not eliminated the possibility of a the system ID being equivalent to a user

ID. Thus a valid interpretation of the term "system ID" is the user ID of Neville et al..

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 6, 7, 10-12, 14, 23, 24, and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Neville et al., U.S. Patent No. 6,272,636.

As per claims 1-3, 14, 23, 24, and 26, Neville et al. teach a system for remotely enabling software comprising: receiving a user ID at a centralized facility from a user, an option-enabling request from the user specifying an option requested to be enabled in equipment at a subscriber station, confirming that the feature has not already been enabled, electronically sending an enabling feature (e.g. electronic confirmation) from the centralized facility to the equipment in the subscribing station and activating the option in the equipment (column/line 13/13-

14/15). Neville et al. also teach a software key to enable software previously installed equipment (column/line 13/13-14/15).

As per claims 6 and 7, Neville et al. teach authenticating a user ID and downloading the enabling feature automatically and without further user input (column/line 13/13-14/15).

As per claim 10, Neville et al. also teach validating an options request, creating an option key in response thereto, a communications network for relaying data, and transmitting the option key through an external communications network ('636, column 10, lines 62-65; column/line 13/13-14/15).

As per claim 11, Neville et al. teach receiving and validating a user ID, receiving an option request from a user and invalidating a user ID (column/line 13/13-14/15).

As per claim 12, generating an option key for a specific client computer ('636, column/line 10/62-11/5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5, 13, 15, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636.

As per claims 4, 5, 13, 15, and 25, Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a medical imaging scanner. However, an "end-user computer" (column 10, lines 62-67) is elastic enough to encompass any device that "accepts structured input, processes it according to prescribed rules, and produces the results as output." Regarding claim 5, Neville et al. specifically recite "try before you buy", and "crippled" software distribution models (column 2, lines 11-47), therefore, it would have been obvious to one of ordinary skill to use the secure product execution method of Neville et al. to activate options (column/line 13/13-14/15).

7. Claims 8, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 in view of Linden et al., U.S. Patent No. 6,360,254.

As per claims 8, 9, and 16, Neville et al. teach a system for enabling software options in a computer (abstract). However, Neville et al. do not specifically recite sending enabling features by e-mail and electronic confirmation of the option enablement. Linden et al. teach a secure method for enabling a remote computer to access a resource comprising sending an enabling feature

by e-mail and sending a verification e-mail to the user confirming option enablement (column 11, lines 28-39). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Linden et al. as Neville et al. generally recite a server computer enabling a software feature running on a remote client system via telecommunication means and services ('636, column 10, lines 62-65). Hence as electronic mail is such a means and service it would have been obvious to use the e-mail teaching of Linden et al. ('254, column 11, lines 28-39).

8. Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 in view of Ernest, U.S. Patent No. 4,888,798.

As per claims 17-22, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a medical imaging scanner. However, an "end-user computer" (column 10, lines

62-67) is elastic enough to encompass any device that “accepts structured input, processes it according to prescribed rules, and produces the results as output.” Neville et al. also recite “try before you buy” and “crippled” software distribution models (column 2, lines 11-47). Specifically, Neville et al. recite evaluation periods based on a number of executions or time periods (column 13, lines 60-67). However, Neville et al. do not specifically recite a software key with a disablement feature. Earnest teaches a system for securing distributed software using software keys, with a predetermined time based disablement option, to unlock specific features (column/line 14/66-15/30). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Earnest in order more securely control trial period software.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:


(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

November 4, 2003


JOHN W. HAYES
PRIMARY EXAMINER